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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,512	01/22/2001	William Vong	MS1-155USC3	3413

22801 7590 07/09/2003

LEE & HAYES PLLC  
421 W RIVERSIDE AVENUE SUITE 500  
SPOKANE, WA 99201

EXAMINER

SHIN, CHRISTOPHER B

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 07/09/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/767,512

Applicant(s)

VONG ET AL.

Examiner

Christopher B Shin

Art Unit

2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18-20,23 and 40-47 is/are pending in the application.
- 4a) Of the above claim(s) 40 and 47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-20,23 and 41-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The Amendment received June 16, 2003 has been entered and carefully considered. Claims 18-20, 23 & 40-47 are pending in the application. Claims 40 & 47 are withdrawn from consideration.

Claim 40 & 47 raises potential Double Patenting rejection against the Parent Patent(s), if the claims 40 & 47 are considered. The examiner notes that the earlier parent applications had restrictions requirements including the above subject matter.

#### ***Original Presentation***

2. As can be seen from claims 40 & 47, the limitations of the claims 40 & 47 present a subject matter that are not originally elected by the applicant. As can be seen from claims 18, 19, 20, 23, 42, the original invention is directed to LED limitations without power limitation; however, claims 40 & 47, in addition to the originally elected invention claims, now additionally elects the invention (e.g., power) that are patentable distinct from the originally elected claims. Claim 47 is respectively separate invention groups from the claims 18-20, 23 & 40-47. Within the group claim 18-20 23 & 40-47, the claim 40 is a distinct specie. All of the two separate inventions group I (claims 18-20, 23, 41-46) & group II (claims 40 & 47) are related as subcombinations usable together.

#### ***Response to Arguments***

3. Applicant's arguments with respect to claims 18-20, 23 and 41-46 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Establishment of Well Known Prior Art***

4. Examiner would like to establish that LED (light emitting diode/device) are well known as being one of the common elements in the portable computer environment (supported by Paulick 6,018,584 and many more in the art). Furthermore, the color, shape, size, and location of such

LED is clearly within the choice of the designer, as supported by the examiner cited prior art of record and more not yet cited but the examiner would like give official notice on such well known design choices. In addition, in most cases, the LEDs are used to notify the user of a certain event or condition to a user. For example, every laptop, handheld/palm top, desk top, and main frame, peripherals, and more usually have one or more LEDs to indicate conditions or notify the user events. The examiner also give official notices on such well known common knowledge. For the above reasons, the examiner strongly believes that the present claimed inventions are not allowable over the prior art of record. There are many prior art teaches the claimed functional equivalent of notifying events from multiple direction due to a physical shape/design of LEDs.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 18-20 and 42-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Seto et al (5,552,967).

The Seto reference teaches all of the functional equivalent claimed limitations as follows:

Claim 18

Seto et al.

- portable handheld computing device comprising

- feature of figure 1
- casing having upper and lower surfaces, opposing front and back side surfaces, and opposing end surfaces, the ends being dimensionally shorter than the front and back side surfaces
  - feature of figure 1
- light emitting device (LED) mounted externally on the casing, the LED being positioned on the upper surface and wrapping around to and being raised on one of the end surfaces
  - feature (254)
- LED being activated upon occurrence of an event to notify a user
  - inherent feature of (254)

Claim 19                      Seto et al.

- portable handheld computing device comprising
  - feature of figure 1
- casing having a base and a lid
  - feature of figures 1 & 8
- the LED being activated upon occurrence of an event to notify a user
  - inherent feature of (254)

Claim 20                      Seto et al.

- portable handheld computing device comprising
  - feature of figure 1
- casing having a base and a lid that opens and closes relative to the base
  - feature of figures 1 & 8
- the lid having an upper surface, opposing side surfaces, and opposing end surfaces
  - feature of figure 8
- LED device mounted externally on the casing
  - feature of figures 1 & 8
- LED being activated upon occurrence of an event to notify a user
  - inherent feature of (254)
- positioned on the upper surface of the lid, and wrapping around to one of the end surfaces so that the LED is visible from both opposing side surfaces and both opposing end surfaces when the lid is opened or closed
  - feature of figures 1 & 8

Claims 42-44                      Seto et al.

- portable handheld computing device comprising
  - feature of figure 1
- casing having upper and lower surfaces, opposing front and back side surfaces, and opposing end surfaces
  - feature of figure 1
- LED device mounted externally on the casing

- feature of figures 1 & 8
- LED being activated upon occurrence of an event to notify a user
  - inherent feature of (254)
- positioned such that the LED is visible from both opposing side surfaces and one of the end surfaces
  - feature of figures 1 & 8
- wherein the LED is further visible from another end/side surface
  - feature of figure 1

Since the Seto reference teaches all of the functional equivalent claimed limitations, the claimed invention would have been anticipated the Seto reference.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 23 & 41, 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seto et al. (5,552,976) in view of Maddrell et al (6,041,215) or Weber (4,056,701) or Wunsch et al. (4,454,596) or Hidaka (5,606,712).

i. The examiner relies on the examiner cited references as being the well known common knowledge in the art LED alert/display notification technique as stated above.

ii. The difference between the claimed invention and the teachings of the Seto reference is that the reference does not expressly disclose the exactly same physical shape of LED (i.e., physical situations of the LED) & the off button integration. However, such difference in limitation is a design choice matter to one having ordinary skill in the art. The examiner takes official notice on such design choice matter such as off button integration (e.g., as can be seen from the examiner cited references, Maddrell et al (6,041,215) or Weber (4,056,701) or Wunsch

et al. (4,454,596) or Hidaka (5,606,712), all teach the well known light emitting device & button combinations) This is because the physical situation of the LED is chosen by the designer with a motivation of choosing better visible location; one skilled artisan can easily choose a specific location or more than one locations to serve the purpose of alerting a user. . Therefore, it would have been obvious at the time the invention was made to one having ordinary skill in the art to come up with the invention from the teachings of the Seto reference, for the reasons stated above.

**9. Any Response To This Action Should Be Mailed To:**

**If The Action Is Non-Final**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 746-7239, (for formal communications intended for entry)

**If The action is Final**

**Box AF**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 746-7238, (for formal communications; please mark "EXPEDITED  
PROCEDURE")

**Hand-delivered responses should be brought to**

Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

**Any Other Telephone Communication Should Be Directed To**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mr. Shin whose telephone number is (703) 305-9658. The examiner can normally be reached on Monday - Thursday from 7:00 AM to 4:00 PM.

Christopher B. Shin  
June 27, 2003

*Christopher B. Shin*  
**PRIMARY EXAMINER**  
**ART UNIT 2182**

